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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/862,648	05/22/2001	Roger Woodruff	1370.018US1	8678
21186	7590	11/29/2005	EXAMINER	
SCHWEGMAN, LUNDBERG, WOESSNER & KLUTH 1600 TCF TOWER 121 SOUTH EIGHT STREET MINNEAPOLIS, MN 55402			LIM, KRISNA	
			ART UNIT	PAPER NUMBER
			2153	

DATE MAILED: 11/29/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 09/862,648	Applicant(s) ROGER WOODRUFF	
	Examiner Krisna Lim	Art Unit 2153	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 15 September 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-31 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-31 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

1. Claims 1-31 are still pending for examination.

2. Claims 1-2 are rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

In claims 1 and 26, it is unclear how a device is discovered. It is unclear from where and to where the encoded name is transmitted across a network.

In claims 2 and 27, it is unclear where the encoded name is received. It is unclear from where the name is sent to a host.

In claim 3, the interconnection among the device, the host and the server is not understood.

In claim 7, it is similar to claims 1-3 above. Moreover, it is unclear how those adapters are connected in the server.

In claim 10, it contains similar problem as in claims 1-3 above. Moreover, it is unclear how those adapters are connected in the client.

In claim 14, it contains similar problems as in claims 1-3 above.

In claim 18, it is unclear what comprises those features of discovering, determining, encoding and transmitting. It is not understood how a signal-bearing media comprises those features.

In claim 22, it contains similar problem as in claim 18.

3. 1. Claims 1-19 are presented for examination.

2. The non-statutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper time-wise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA

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1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970);and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a non-statutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

3. Claims 1-19 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being un-patentable over claims 1-21 of co-pending Application No.10/007,064. Although the conflicting claims are not identical, they are not patentably distinct from each other because the difference in scope is not substantial enough. For example, the present application calls for a method for managing content displayed on an information management unit and the feature of displaying information related to the first and second inputs and to switch between a first synchronized datastream input and a second unsynchronized datastream input while the co-pending application calls a method for enabling coordinated (e.g., managing of the present application) session of a television program (e.g., content displayed on the information management unit of the present application) related to the first and second interconnection networks (e.g., the first and second inputs of the present application) and to switch between a first synchronized datastream input and a second unsynchronized datastream input,

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

4. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefore, subject to the conditions and requirements of this title.

5. Claims 18-25 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter as being an intangible media (e.g., a signal-bearing media) and an abstract idea. A signal-bearing media is incapable of being touched or perceived absent the tangible medium through which they are conveyed. Moreover, a medium containing machine-readable code would normally considered statutory subject matter. However, the instruction to provide signals is not tangibly embodied in a manner so as to be executable as the only hardware is in an intended use statement. Since it is the intent of the execution of a medium and not the medium itself that includes such hardware, thus this claim is not tangible.

6. The following is a quotation of 35 U.S.C. § 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. Claims 1-31 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Punj [U.S. Patent No. 5,289,579] in view of Gioquindo et al. [U.S. Patent No. 6,334,154].

8. Punj disclosed (e.g., see Figs. 1-6) the invention substantially as claimed. Taking claims 1, 5-7, 10, 18, 22 and 26-27 as exemplary claims, the reference discloses: a device (e.g., see col. 3, line 16); a name associated with the device (e.g., printers, discs, tape units, software systems, etc., col. 3, line 17); encoding the name into a second protocol format (e.g., see col. 2, lines 48-53).

While Punj disclosed that his data in a channel format are converted or encoded into a different format in order to allow the data to be transmitted over the network, Punj

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did not explicitly mention the use of the address resolution protocol for converting data format according to the client format in order to transmit the data between a client and a server. Such compatible feature of allowing data with different protocol formats to be transmitted among clients and a server would have been a desirable feature in the art, thus it would have been obvious to one of ordinary skill in the art to combine the teaching of Gioquindo's address resolution protocol into Punj's address conversion (e.g., see the abstract, Figs. 5-7, col. 6 (lines 1-34), col. 10 (lines 6-45)).

9. As to claims 3-4, 8-9, 11-17, 19-21, 23-25 and 28-31, Gioquindo disclosed a protocol format is Fibre Channel (e.g., see 22 of Fig. 1, col. 4 (line 3) and the second protocol is iSCSI over TCP/IP (e.g., see col. 3 (line 45) and col. 7 (line 47)).

10. Applicant's arguments, see the remark, filed 9/15/05, with respect to the rejection(s) of claim(s) 1-31 under Kronz and Ross have been fully considered and are persuasive. Therefore, the rejection has been withdrawn. However, upon further consideration, a new ground(s) of rejection is made in view of the above rejection.

11. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

The references are cited in the Form PTO-892 for the applicant's review.

A shortened statutory period for response to this action is set to expire 3 (three) months and 0 (zero) days from the mail date of this letter. Failure to respond within the period for response will result in **ABANDONMENT** of the application (see 35 U.S.C 133, M.P.E.P 710.02, 710.02(b)).

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Krisna Lim whose telephone number is 571-272-3956. The examiner can normally be reached on Monday to Wednesday and Friday from 7:30 AM to 4:00 PM.

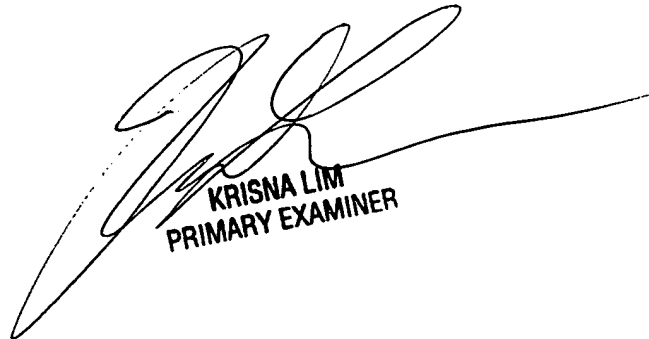
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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Glenton Burgess, can be reached on 571-272-3949. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

KI

November 28, 2005



KRISNA LIM
PRIMARY EXAMINER